UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,143	01/21/2000	William J. Baer	STL000020US1	5414

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EXAMINER
SMITH, PETER J

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/489,143	BAER ET AL.
	Examiner	Art Unit	
	Peter J. Smith	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 August 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: appeal filed on 8/2/2005.

2.   Claims 1-27 are pending in the case. Claims 1, 9, and 17 are independent claims.

3.   In view of the appeal brief filed on 8/2/2005, PROSECUTION IS HEREBY

REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an

appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee

can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

been increased since they were previously paid, then appellant must pay the difference between

the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing

below:

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   **Claims 1-8 and 17-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** These claims are directed towards a method and system for determining a content count for a content object and determining from the content count a price for the content object. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. The limitations require determining a content count for the content object and determining from the content count a price for the content object. Therefore, one interpretation of these limitations reads upon performing these steps using a pencil, sheet of paper, and a person's mind. A person could mentally determine a count for a content object, recording the count on a sheet of paper if necessary. Then the person could mentally determine a price based on the mentally derived content count, referencing the price on a sheet of paper if necessary. Thus, under one interpretation, the claims read upon a mental process which is not necessarily tied to a technological art, environment, or machine. The Examiner's suggestion to overcome this rejection is to amend the preamble to recite, "A computer-implemented method for determining . . ." in claim 1 and "A computer-implemented system for inserting . . ." in claim 5, such that the claimed invention no longer reads upon a mental process.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   **Claims 1-2, 9-10, and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated**

by Dedrick, US 5,768,521 patented 6/16/1998.

          Regarding independent claims 1, 9, and 17, Dedrick discloses determining a content

count for a content object and determining from the content object count a price for the content

object in col. 1 line 62 – col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 – col. 5 line 25, and

col. 7 lines 29-43.

          Regarding dependent claims 2, 10, and 18, Dedrick discloses determining a content

count for each content entity, and summing the entity content counts to obtain a content count for

the content object in col. 1 line 62 – col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 – col. 5

line 25, and col. 7 lines 29-43.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   **Claims 3-6, 11-14, 19-22, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick, US 5,768,521 patented 6/16/1998.**

Regarding dependent claims 3, 11, and 19, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 – col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 – col. 5 line 25, and col. 7 lines 29-43. Dedrick teaches specific examples that the content count unit may be in bytes or words in col. 4 lines 63-64. Dedrick does not specifically teach that the unit of information is a character count. However, Dedrick's teaching of a byte unit count will correlate exactly in proportion to the size of the content entity just as a character count will correlate exactly in proportion to the size of the content entity. Each additional character contained in the content entity will increase the representative byte count by the same unit amount that a character count would increase. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dedrick to have used a character for the content entity.

Regarding dependent claims 4, 12, and 20, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 – col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 – col. 5 line 25, and col. 7 lines 29-43. Dedrick teaches specific examples that the content count unit may be in bytes or words in col. 4 lines 63-64. Dedrick does not specifically teach that the unit of information is a character count. However, Dedrick's teaching of a byte unit count will correlate exactly in proportion to the size of the content entity just as a character count will correlate exactly in proportion to the size of the content entity. Each additional character contained in the content entity will increase the representative byte count by the same unit amount that a character count would increase.

Determining a page count from the character count is merely changing the units of the count from characters to pages. Dedrick teaches a information unit count of bytes in col. 4 lines 63-64 and megabytes in col. 5 lines 21-23. The two example units of Dedrick are related exactly as the characters and pages of the claimed invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dedrick to have converted characters into pages so that the cost computation could have been simplified.

Regarding dependent claims 5, 13, and 21, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 – col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 – col. 5 line 25, and col. 7 lines 29-43. Dedrick teaches specific examples that the content count unit may be in bytes or words in col. 4 lines 63-64. Dedrick does not specifically teach that the unit of information is a character count. However, Dedrick's teaching of a byte unit count will correlate exactly in proportion to the size of the content entity just as a character count will correlate exactly in proportion to the size of the content entity. Each additional character contained in the content entity will increase the representative byte count by the same unit amount that a character count would increase. Dedrick teaches counting the number of bytes in a content entity, determining the content entity type, and determining an average character count for content entities of that type in col. 1 line 62 – col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 – col. 5 line 25, and col. 7 lines 29-43.

Regarding dependent claims 6, 14, and 22, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 – col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 – col. 5 line 25, and col. 7 lines 29-43. Dedrick teaches specific examples that the content count unit may be in bytes or words in col. 4 lines 63-64. Dedrick does not specifically

teach that the unit of information is a page count. However, Dedrick's teaching of a byte unit

count will correlate exactly in proportion to the size of the content entity just as a page count will

correlate exactly in proportion to the size of the content entity. Each additional page contained

in the content entity will increase the representative byte count by the same unit amount that a

page count would increase. Dedrick teaches multiplying the page count with a predetermined

price per page in col. 1 line 62 – col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 – col. 5 line

25, and col. 7 lines 29-43.

Regarding dependent claims 25, 26, and 27, Dedrick teaches wherein the content

object comprises electronic text, audio, video, graphics, animation or other electronic

information in col. 4 lines 26-51. An electronic book is a composition of electronic information

as is described by Dedrick. Dedrick teaches wherein the electronic information content entity is

interactively created by the end user in col. 4 lines 39-51. It would have been obvious to one of

ordinary skill in the art at the time the invention was made to have modified Dedrick to have

enabled an end user to have interactively created an electronic book by selecting from a plurality

of electronic information content entities so that the user could have had a customized electronic

book.

8.   **Claims 7-8, 15-16, and 23-24 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Dedrick, US 5,768,521 patented 6/16/1998 in view of Khan et al.

(hereinafter "Khan"), US 6,199,054 B1 filed 3/5/1998.

Regarding dependent claims 7, 15, and 23, Dedrick teaches wherein a user may

interactively select from a plurality of content entities to form a customized content object in col.

1 line 62 – col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 – col. 5 line 25, and col. 7 lines 29-43. Dedrick teaches variable content entity pricing in col. 5 lines 23-25. Dedrick does not teach that at least one of the content entities comprises user provided content. Khan does teach wherein a user may selectively add a user-provided content entity subject to price metering in col. 3 lines 61-64. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the user-provided content teaching of Khan into Dedrick to have created the claimed invention. It would have been obvious and desirable to have allowed the user to have provided content to further customize the interactive selection of content entities composing the content object.

Regarding dependent claims 8, 16, and 24, Dedrick teaches wherein the price for user-provided material is determined in a first manner if the content count exceeds a predetermined content count maximum, and is determined in a second manner if the content count does not exceed the predefined maximum in col. 5 lines 23-25.

Response to Arguments

9.   Applicant's arguments filed 8/2/2005 have been fully considered but they are not persuasive. Regarding Applicant's argument in pages 9-11 that Dedrick does not anticipate all the limitations of independent claims 1, 9, and 17, the Examiner respectfully disagrees. Dedrick discloses a plurality of different cost types in col. 4 line 26 – col. 5 line 25 such as pay per view, pay per byte, or pay per time, for example. The Examiner believes the disclosure of Dedrick teaches different ways of charging a price in both a way that does and a way that does not require a cost count. Thus, the Examiner's comments in previous actions were attempting to show that

the Dedrick does not generate a price necessarily excluding the use of a content count. Dedrick, for example, teaches calculating a price of requested information in col. 3 lines 60-63. Since Dedrick is teaching "calculating" a price, it necessarily must use at least a content count and a content value to derive the content price. Another example of where Dedrick explicitly teaches calculating a price using a content count is in col. 7 lines 29-43. Dedrick discloses here that a if the cost type associated with the information is per time or per byte/word, the metering server may periodically determine if the balance is being exceeded by the consumption of information. Since the metering server periodically determines the price, it must necessarily count the bytes or words consumed during that period of time to determine the appropriate price to subtract from the balance. Therefore, the Examiner maintains that Dedrick does teach a cost count for some of the cost types which it discloses because it teaches calculating the a price over a period of time. It is for at least these reasons that the Examiner maintains the rejection of claims 1, 9, and 17 as being anticipated by Dedrick.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adam et al., "Strategic Directions in Electronic Commerce and Digital Libraries: Towards a Digital Agora", ACM Computing Surveys, vol. 28, issue 4 (December 1996), pages 818-835 discloses combined electronic commerce and digital library systems. Henke, Harold, "The Global Impact of eBooks on ePublishing", Proceedings of the 19th annual international conference on Computer documentation, 2001, pages 172-180 discloses an overview of eBook publishing models.

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Peter J. Smith whose telephone number is 571-272-4101. The

examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS
10/14/2005

WILLIAM BASHORE
PRIMARY EXAMINER

10/16/2005